

REMARKS

The office action issued by the Examiner and the citations referred to in the office action have been carefully considered.

Claim Rejections - 35 U.S.C. § 101

Claims 1-22, 23-43 stand rejected under 35 U.S.C. § 101 as claims directed to non-statutory subject matter, specifically to computer programs without an recitation of structural or functional interrelationships between the computer program and the other claimed elements of the computer that permit the computer program's functionality to be realized. **The Examiner is respectfully directed to amendments to the claims listed herein to address the Examiner's 35 U.S.C. § 101 rejections and consequently renders the rejections moot.** The Inventor respectfully submits that the rejection is traversed.

Claim Rejections - 35 U.S.C. § 103

Claims 1-7, 11-13, 15-16, 20-34, 36-44, 46-54, and 58 stand rejected as being unpatentable over Maehara et al. (Patent No. 6,556,201) in view of a permutation of other references.

I. Non-Analogous Art is Cited Against the Inventor as a Basis of the Rejection

To make a proper § 103 rejection, the art cited must be analogous. Accordingly, **art outside of the inventor's field may be considered to be analogous art if the subject matter disclosed is relevant to the particular problem with which the inventor is involved.** *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F. 2d 858 (Fed. Cir. 1993); *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057 (Fed. Cir. 2003).

Maehara, which is the backbone of each § 103 rejection, is not analogous to the Inventor's disclosure because the problems addressed are not the same. Although both address aspects of viewing images on a computer, **Maehara addresses problems inherent in 3D graphics rendering** while the Inventor addresses the problem of providing a simple interface to view items in 3D from various angles, where no 3D graphics engine is necessary.

Maehara addresses the problem of creating non-polygonic characters in three dimensional computer graphics applications, which prevents the processors from otherwise needing to render and draw thousands of polygons to accurately depict a moving animal. Accordingly, Maehara disclosed a method of having a 3D renderer render all the 3D images except for a moving animal. The moving animal is selected from a collection of prerecorded images of a moving animal captured at for a variety of angles. The angle selected is calculated by the computer and inserted into a virtual frame within the overall rendered 3D image to provide the illusion of a perfectly rendered animal in a rendered 3D landscape. In fact, Maehara does not facilitate anywhere the problem of easily viewing various aspects of the images as the user cannot directly manipulate the image placed into the graphics.

Conversely, the Inventor does not address any problems inherent with 3D graphics. Rather, the **problem addressed by the Inventor is providing a vehicle to allow a user to conveniently view an image of an object in each of its three dimensions**. Thus, image layers are simultaneously provided at various angles and shown one at a time according to the various manipulations of a user interface. To that end, a plurality of transparent layers are provided to allow the user to change the placement on the screen of the images and to measure actual dimensions of the images, for example.

Thus, on one hand the problem addressed in Maehara is improving 3D graphics in applications such as video games. On the other hand, the Inventor addresses the problem of providing a simple interface for allowing users to look at various aspects of

an object on a computer screen. Consequently, **the art cited against the Inventor is non-analogous, and the rejection is traversed.**

II. No Motivation, Suggestion, or Teaching Exists in the Art for Combining the References

The Examiner's rejections are improper based upon hindsight.

The Federal Circuit's current test is the motivation, suggestion, or teaching test, stating motivation is decided based on **"whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims."** *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, (Fed. Cir. 06-1088, October 3, 2006). The Examiner has the burden of explaining the motivation, suggestion, or teaching as part of the *prima facie* case. **If the explanation is omitted, the Examiner's rejection is based on impermissible hindsight.** *In re Kahn*, (Fed. Cir. 04-1616, March 22, 2006).

Moreover, 35 U.S.C. § 103 requires that the subject matter "as a whole" must be obvious in order for an invention to be found unpatentable. Of course, recognition of the problem as part of the inventor's subject matter as a whole, and where the recognition of the problem was not present in the cited art, and where the claims define the entire invention, patentability is clearly present.

Here, the Examiner **did not cite the motivation in any of the cited references to combine with Maehara to provide a *prima facie* case of obviousness.** As addressed earlier, the problems addressed between Maehara and the Inventor's subject matter are not the same. Thus, without some indication in the references for combining the teachings found therein, an obviousness rejection is untenable.

Moreover, with regard to "broad-brush" statements regarding motivations or certain matters being "well known in the art" or obvious, the Inventor respectfully traverses all such reasons for rejections, which essentially are asserting facts with no prior art support. With regard to such unsupported assertions, they have been condemned in a recent decision of the Court of Appeals for the Federal Circuit in the case of *In re Zurko*, (Fed. Cir. No. 96-1258; August 2, 2001). In this case the Court stated: "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** — or on its assessment of what would be basic knowledge or common sense. Rather, the Board **must point to some concrete evidence in the record in support of these findings.**" It is further noted that these broad-brush assertions in the rejection are in lieu of citing further references, which would make a rejection of the pending claim based on a further combination of these multiple references even less valid or compelling.

The broad-brush approach of explaining the teaching of each reference and concluding that if combined the Inventor's subject matter would be obvious constitutes impermissible hindsight without an explanation of the motivation, suggestion or teaching behind the combination. Indeed, **without the concrete evidence required to explain the motivation, suggestion, or teaching used to combine the references**, it must be inferred **that impermissible hindsight is the basis of the combination of references and resulting rejections.**

The Inventor respectfully submits the Examiner's explanations of each combination of art do not sufficiently explain the necessary motivation, suggestion, or teaching for combining the references cited. Thus, a *prima facie* case of obviousness has not been presented. Accordingly, the Inventor courteously submits that the rejections are traversed.

Claim Rejections - 35 U.S.C. § 102

Claims 56 and 57 directed to a lenticular sheet assembly stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gulick, Jr. et al (Patent No. 6,373,637). In order to overcome an anticipation rejection, the Inventor need only demonstrate that the references fail to teach each and every claimed limitation. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Here, the Examiner points to col. 6, lines 13-21 of Gulick to support an argument that Gulick discloses the following limitations as claimed:

- a lenticular layer with a plurality of lenticular lenses on which at least one image has been deposited;
- a means for retaining the lenticular layer on a support surface;
- **a gap between the lenticular layer and the support surface.**

However, the cited text (col. 6, lines 13-21) of Gulick do not refer to a gap. Indeed, the cited text actually refers to a novel herringbone approach to lenticular sheets that is not disclosed or claimed by the Inventor. Moreover, **nowhere in Gulick is a gap referenced between the support surface and the lenticular lenses, as claimed by the Inventor.** Additional support for the Inventor's argument may be found by reference to the drawing cited by the Examiner in the office action. Clearly, the drawing does not show a gap between the lenticulae and a support surface (the dotted line represents the actual images) as shown in the Inventors Fig. 25 and referenced by numeral 724. According to the Inventor's specification, the gap comprises air or "some other gas or a gel or gel-like material to facilitate and/or enhance relative motion between the lenticular sheet and the support surface."

Additionally, the Inventors would like to bring to the Examiner's attention a key difference between Gulick and the present disclosure. Prior lenticular sheets, including that of Gulick, were operated by changing the angle in which the images were viewed by

moving the entire sheet. Here, **images are viewed by applying pressure to the lenticular sheet**, for example with a finger, **which comprises a novel way of approaching viewing of the sheet.**

Thus, **each claimed limitation in the application's claims are not disclosed by Gulick.** The Inventor therefore courteously submits that the Examiner's rejections are traversed.

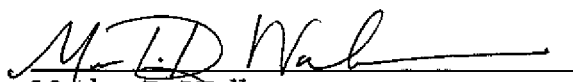
It is respectfully submitted that all of the Examiner's objections and rejections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

New claims 59-61 do not introduce new matter and improve the flow of dependencies of the first independent claim. New claim 62 does not introduce new matter and highlights the novelty of the pressure activated feature of the Inventor's lenticular sheets.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638.** Please ensure that Attorney Docket Number 075997.010100 is referred to when charging any payments or credits for this case.

Respectfully submitted,

Date: December 29, 2006


Marlan D. Walker
Reg. No. 56,928

Customer Number 33717
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-7700
Fax: (310) 586-7800
E-mail: laipmail@gtlaw.com